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08/530.729 09/19/95 SIMONE

24M1/0130

DICKSTEIN SHAPIRO & MORIN  
2101 L STREET N W  
SUITE 400

This is a continuation of the application of the inventor in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

EXAMINER	
C	S4264.000/P0
ART UNIT	PAPER NUMBER
THOMAS, J	17

DATE MAILED:  
2411

01/30/96

- ☒ This application has been examined ☒ Responsive to communication filed on 9/19/95 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |   |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.                 | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.       |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474.     | 6. <input type="checkbox"/>   |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-8 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☒ Claims 1-8 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

**Part III DETAILED ACTION**

***Notice to Applicant***

1. This communication is in response to the preliminary amendment of the application filed 9/19/95. Claims 1-8 remain pending.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

3. Claims 1-8 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter, in particular, a method of doing business.

Claims reciting a method of doing business do not fall within the statutory classes set forth in 35 U.S.C. § 101. See Hotel Security Checking Co. v. Lorraine Co., 160 Fed. 467 (1908), In re Wait, 24 USPQ 88 (CCPA 1934), Loew's Drive-In Theaters v. Park-In Theaters Inc., In re Patton, 53 USPQ 376 (CCPA 1942), 81 USPQ 149 (Court of Appeals, 1st Circuit 1949), and Ex parte Murray, 9 USPQ 2d 1819 (PTO Bd. Pat. App. & Int'f, 1988).

The present set of claims are populated with steps or means, stated and repeated in various levels of detail, for performing functions which clearly comprise a method of doing business.

In particular, it is the position of the examiner that the claimed steps of (or means for) evaluating insurability of an individual by gathering and storing information, assigning weight values to the received information,, determining a total value, comparing the information to provide suggestions and a level of insurance risk, are all functions normally performed by insurance sales personnel, and thus may be fairly characterized as a method of doing business.

The "means for" claim construction does not render the claims statutory in view of decisions expressed in In re Maucorps, 203 USPQ 812, In re Walter, 205 USPQ 408, and Ex parte Akamatsu, 22 USPQ 2d 1915. E.g., see Walter, 205 USPQ at 397:

"If the functionally-defined disclosed means and their equivalents are so broad that they encompass any and every means for performing the recited functions, the apparatus claim is an attempt to exalt form over substance since the claim is really to the method or series of functions itself. In computer-related inventions, the recited means often perform the functions of "number crunching" (solving mathematical algorithms and making calculations). In such cases the burden must be placed on the applicant to demonstrate that the claim is truly drawn to the specific apparatus distinct from other apparatus capable of performing the identical functions.

The nominal recitation of computer hardware (e.g., "computer" and "memory") does not render the claims statutory in view of Ex parte Akamatsu, 22 USPQ 1915 (1992) decision:

"A common factor in Maucorps, Walter, Pardo, Abele, and Meyer, was that the disclosed apparatus in the specification was apparently a known type of stored program digital computer . . . The fact that the disclosed apparatus was a known computer was apparently evidence that the invention was really in the process embodied in a computer program rather than in the apparatus" (emphasis added).

"That the apparatus distinguishes over a general purpose computer is considered to be a key factor in cases involving mathematical algorithms".

The same reasoning is set forth in the earlier Supreme Court decision Gottschalk, Commr. Pats. v. Benson, 175 USPQ 673 (1972):

"The mathematical formula involved here has no substantial practical application except in connection with a digital computer, which means that if the judgement below is affirmed, the patent would wholly pre-empt the mathematical formula and in practical effect would be a patent on the algorithm itself".

It is the position of the examiner that, considering the wide-spread use of computers to perform business functions, the nominal recitation of a computer to perform a business function fails to define a "specific apparatus distinct from other apparatus capable of performing the identical functions" (as required by Walter). The nominal recitation of a computer may rule out pre-emption with respect to a "pencil and paper" mode of performing business, but leaves intact the issue of "practical pre-emption" (as defined by Benson).

More in general, in evaluating whether a case recites a statutory subject matter under 35 U.S.C. 101, "the claimed invention, as a whole, must be evaluated for what it is", In re Sarker, 200 USPQ 132. As paraphrased in In re Abele, "The goal is to answer the question 'What did the applicants invent?'". Resolving these basic inquired required "careful interpretation of each claim in light of its supporting disclosure", In re Johnson, 200 USPQ at 208.

The fact that the claimed steps are carried out on a

computer system does not automatically transform the claims into statutory subject matter. General purpose computers are simply tools in performing day-to-day functions in the same genre as pencil, paper, handheld calculator, etc. According to *In re de Castelet*, 569 F.2d 1236 (1977) "claims to non-statutory processes do not automatically and invariably become patentable upon incorporation of reference to apparatus." Further, a general purpose computer is not considered a specific apparatus distinct from other apparatus capable of performing the identical functions as required by *In re Walter*, 205 USPQ 397, 408. Thus, the recitation of a computer should not shroud the issue of this case; it is apparent from the specification that the inventive premise resides in a financial principle or technique rather than the apparatus claimed. On this basis, examiner respectfully submits that the recitation of a computer in a claim should be treated in the same light as these other "dy-mystified" business tools.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

5. Claims 1-8 are rejected under 35 U.S.C. § 103 as being unpatentable over DeTore et al (4,975,840).

(A) As per claim 1, DeTore et al. disclose a computer system for evaluating a potentially insurable risk. the system comprises an application database which includes a survey for gathering information pertaining to an individual's health and medical test; an entry means for inputting the gathered information (fig. 1, element 16); a memory for receiving and storing the gathered information (fig. 1, element 12); and assigning weight and risk value to the stored information (col. 41, lines 48-64). DeTore et al. further disclose determining the total of weight and risk values and comparing the total values to the pre-defined values on the same claims (col. 42, lines 55-63) and a message or suggestion is provided for improving health and decreasing risk (col. 2, lines 31-38: cols. 19-22, "Treatment" section --shows that messages are provided to an individual having a medical problem, hypertension, as well as suggestions on how to improve their health conditions; and cols. 35-36). The system also determines the level of insurance risk and communicates the level of risk (col. 18, lines 11-32). DeTore et al. fail to recite that the information gathered from an individual also includes

the lifestyle of that individual. However, many medical result are typically based upon the lifestyle of an individual. For example, certain behavioral patterns in lifestyle have a direct affect on an individual's medical status. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include lifestyle information as an independent category along with medical and health data gathered by the DeTore et al. system. The motivation to do so would be to quantitatively assign weight and risk value to lifestyle data for the reason of accurately influencing insurance rates.

(B) Claim 2 recites the risk values are assigned negative values for actions that increase risks and positive values for actions that decrease insurance risks. However, it is well known to one of ordinary skill in the insurance risk evaluation art that positive and negative values to insurance risks is indicative of the strengths and liabilities of an individual's insurability.

(C) As per claim 3, DeTore et al. disclose a memory to store underwriter information (fig. 1, elements 24 and 26).

(D) As per claim 4, DeTore et al. disclose a questionnaire memory to store questionnaires and that an individual can select appropriate responses to lifestyle questions (col. 12, line 37 through col. 13, line 16).

(E) Claims 5-6 recite specific behavioral or lifestyle conditions of an individual such as the food intake of an individual, tobacco use, alcohol use, and an individual's pregnancy status. These are necessary information which are taken into consideration by an insurance agent. It would have been obvious to one of ordinary skill in the art to include's an individual's lifestyle information when buying insurance with the motivation of more accurately determining the insurable risk for that individual.

(F) Method claim 7 is similar in scope to system claim 1, and is therefore rejected under the same rationale given for claim 1.

(G) As per claim 8, DeTore et al. disclose that the gathering of information includes providing an individual with a questionnaire (col. 12, lines 62-66). It is obvious that, if a set of questions are provided to the individual, responses or answers should be received.

***Response to Amendment***

6. Applicant filed several arguments in a communication after final submitted 2/27/95, that had been fully considered but they were not deemed to be persuasive. They were responded to in an advisory action mailed 3/15/95 within the parent case, Serial No. 08/063,734 (Paper number 11).



7. Since no further amendments or arguments have been forwarded by Applicant, the claims remain rejected for the reasons and responses given by the Examiner in the previous Office Actions of the parent case, Serial No. 08/063,734 (Paper numbers 7, 9, and 11), and as reiterated in the preceding sections of the present Office Action.

#### **Conclusion**

8. This is a continuation of Applicant's earlier application S.N. 08/063,734. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds or art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See M.P.E.P. § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Thomas, whose telephone number is (703) 305-9588. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 5:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiners' supervisor, Gail Hayes, can be reached at (703) 305-9711. The fax phone number for this Group is (703) 305-9564 or (703) 305-9565.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3800.

J.T.

Joseph Thomas  
January 5, 1996

  
ROBERT A. WEINHARDT  
PRIMARY EXAMINER  
GROUP 2400